

Applicant: Jansen et al.
Application Serial No.: 10/723,531
Filing Date: November 26, 2003
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REMARKS/ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Claims 24-33 are in the application. Claims 25-33 have been amended to correct their dependency.

In the Official Action, the Examiner rejected claims 25-33 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The Examiner noted that the claims are dependent upon previously cancelled claims. In response, claims 25-33 have been amended to depend from claim 24. It is respectfully submitted that the claims, as amended, are in accord with 35 U.S.C. §112.

The Examiner rejected claim 24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,681,946. In response, attached hereto is a terminal disclaimer in view of U.S. Patent No. 6,681,946 and a check in the requisite amount of \$110.00. If additional fees are required, please charge Deposit Account No. 08-2461. As noted in the Official Action, with the filing of the attached terminal disclaimer, the double patenting rejection has been overcome.

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Claim 24 was also rejected under 35 U.S.C. §103(a) as being unpatentable over Schmidt (U.S. Patent No. 4,412,623) in view of Ida et al. (U.S. Patent No. 6,042,850). The Examiner asserted that various elements of claim 24 are disclosed in Schmidt but also admitted that “Schmidt does not disclose that the slit is biased to a closed position.” To overcome this deficiency, the Examiner asserted that “Ida et al. teaches that it is known to provide a valve member with an opening which is biased to a closed position (see col. 4 line 32).” The Examiner concluded that it would have been obvious to one having ordinary skill in the art to “provide the transfer set of Schmidt with the opening 41 being biased to a closed position, as taught by Ida et al., in order to aid in preventing unintentional escape of the contents.”

Schmidt is directed to a teat feeding bottle having a teat 4 with a teat hole 41 formed in one end thereof. The Schmidt bottle is formed to be completely closed prior to opening to maintain sterile conditions in the bottle. (col. 1, line 65-col. 2, line 4; col. 2, lines 35-36). As described in column 4, lines 36-51, the bottle is opened by applying pressure to closure cap 6, which results in downward movement of spike 3 that penetrates perforated wall 13. To dispense fluid from the open bottle, the closure cap 6 is removed, the container is tilted, and liquid flows out of the teat hole 41. (col. 4, lines 49-51). Because Schmidt explicitly requires the bottle to be tilted to dispense fluid, it is clear that the container of the bottle is vented through the teat hole 41. Although not discussed in Schmidt, venting elsewhere would be undesirable, since such a

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vent passage may provide a pathway for contamination and undermine the desire to maintain sterile conditions.

Ida et al. is directed to a nursing bottle which includes a pouch or bag-like liner 11 that acts as a reservoir. (col. 4, line 37). A nipple 12 is also provided having a self-sealing orifice 18. (col. 4, line 32). As fluid is drawn from the bottle, the liner 11 collapses with the reducing volume. (See, e.g., col. 5, lines 12-14). Because the liner 11 collapses with decreasing volume, venting is not required.

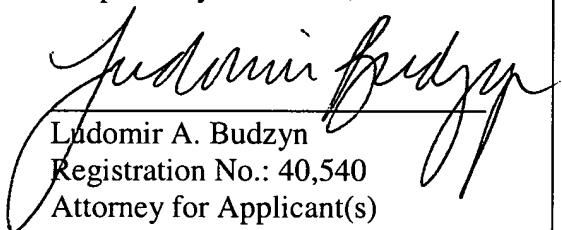
With the hypothetical combination as suggested by the Examiner, the teat hole 41 of Schmidt would be biased to a closed position. However, as pointed out above, the teat hole 41 appears to act as a vent for the internal volume of the bottle. In contrast, the internal volume, within the liner 11, of Ida et al. does not require venting. Accordingly, the orifice 18 of the nipple 12 may be formed to be self-sealing. Because the teat hole 41 of Schmidt appears to be required to be open, there is no motivation to form the hypothetical combination as suggested by the Examiner. (See, MPEP §2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”)). Accordingly, it is respectfully submitted that there is no showing of *prima facie* obviousness. It

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is respectfully submitted that claim 24, along with dependent claims 25-33, are patentable over Schmidt and Ida et al., each taken alone or in combination.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicants' attorney at the number listed below.

Respectfully submitted,


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